

Intellectual Property Office of Singapore Case Summary: Combe International Ltd v Dr. August Wolff GmbH & Co. KG Arzneimittel [2021] SGIPOS 10

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The parties in this dispute had encountered each other in an earlier invalidation proceeding. In *Combe International Ltd v Dr. August Wolff GmbH & Co. KG Arzneimittel* [2020] SGIPOS 3, the Registrar of Trade Marks found that the marks “VAGISAN” and “VAGISIL” were confusingly similar under Section 8(2)(b) of the Trade Marks Act (“the Act”), and that use of the mark “VAGISAN” was liable to be prevented by the law of passing off under Section 8(7)(a) of the Act. This decision was upheld on appeal by the High Court: *Dr. August Wolff GmbH & Co. KG Arzneimittel v Combe International Ltd* [2021] 4 SLR 626.

In the present case, Dr. August Wolff GmbH & Co. KG Arzneimittel (“the Applicant”) applied to register the following trade mark (“the Application Mark”):

The logo for Dr. Wolff's Vagisan. It features the text "Dr. Wolff's" in a smaller, red, sans-serif font above the word "Vagisan" in a larger, bold, red, sans-serif font. The "V" in "Vagisan" is significantly larger and more prominent than the other letters.

in Singapore in respect of the following goods:

Class 3

Toiletries, namely non-medicated cleansers for intimate personal hygiene purposes, vaginal moist crèmes and vaginal salves (not for medical purposes).

Class 5

Medical preparations, namely, medicated ointments for vaginal application, vaginal anti-dermo-infectives suppositories and vaginal anti-dermo-infectives capsules; dietetic preparations and dietary supplements for preserving health of the vaginal mucosa; sanitary preparations and articles for vaginal application.

Combe International Ltd (“the Opponent”) opposed the registration of the Application Mark, citing its earlier registered marks which comprise the word “VAGISIL”.

On the ground of opposition under Section 8(2)(b) of the Act, the Opponent relied on the favourable invalidation decision in *Dr. August Wolff GmbH & Co. KG Arzneimittel v Combe International Ltd* [2021] 4 SLR 626 and submitted that the dominant and distinctive component of the Application Mark is the word “Vagisan”. Hence, comparing the Application Mark with “VAGISIL”, the marks should be found similar. However, the IP Adjudicator found that both “Dr. Wolff’s” and “Vagisan” elements in the Application Mark were distinctive, and that overall, the Application Mark and “VAGISIL” were dissimilar. As such, the ground of opposition under Section 8(2)(b) failed. Given that marks-similarity is also a requisite element under Section 8(4), the ground of opposition under Section 8(4) also failed.

On the ground of opposition under Section 8(7)(a) of the Act, it was undisputed that the Opponent had goodwill in its business in Singapore. However, the IP Adjudicator considered the relevant factors (such as the degree of similarity of the marks, the impression given by the marks, the characteristics of the target audience etc.) and found no misrepresentation. Use of the Application Mark is not likely to result in consumers being deceived or confused into thinking that the Applicant’s goods are those of the Opponent’s, or emanate from a source linked to the Opponent.

As such, the opposition failed on all grounds and the application may proceed to registration.

The IP Adjudicator also commented on a legal issue which did not, eventually, affect the outcome of the case. The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”) at [20] had stated that the assessment of marks similarity is “*mark-for-mark without consideration of any external matter.*” Yet, the same decision stated that technical distinctiveness “*is an integral factor in the marks-similarity inquiry*” (*Staywell* at [25]) and that technical distinctiveness can be inherent or acquired through use. It is only through “*external matter*” that distinctiveness acquired through use is established, hence the perceived difficulty in applying *Staywell*. The fact that the situation is less than clear can be seen from the decision of Lee Sei Kin J in *Polo-Lauren Co LP v United States Polo Association* [2016] 2 SLR 667 at [28] where he said that “*it is less clear whether Staywell contemplates that earlier trade marks which are already inherently distinctive can become more distinctive through use and that this enhanced distinctiveness can be taken into consideration at the marks-similarity stage.*” The IP Adjudicator appreciated that fair arguments could be made either way. In the present case, he took into

account evidence of acquired distinctiveness at the marks-similarity stage, but found that such evidence did not enhance the distinctiveness of the Opponent's mark "VAGISIL".

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2021/combe-international-v-dr-august-woolf-arzneimittel-2021-sgipos-10.pdf>.